



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334

7470 7590 05/05/2011
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

BANSAL, GURTEJ

ART UNIT	PAPER NUMBER
----------	--------------

2189

MAIL DATE	DELIVERY MODE
-----------	---------------

05/05/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/803,173	Applicant(s) CHENG, CHONG SENG	
	Examiner GURTEJ BANSAL	Art Unit 2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/01/2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

In response to Non-Final Office Action dated 05 October 2010, Applicant presents claims 22-30 for examination.

Claim Rejections - 35 USC § 112 (First Paragraph)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "... having a memory space at least as large as the memory space of the magnetic disk or CD." The specification fails to indicate a minimum capacity of memory space within the device or even relate the amount of memory space in the portable USB device to the amount of memory which would be in a magnetic disk or a CD (Please refer to page 8, lines 18-21, of the decision by the Board of Appeals and Interferences dated 11/20/2009 where is it set forth that "[if] claim 22 were to specify that the 'capacity' refers to some minimum amount of memory by a number such as 1.44Mb, we would tend to agree with the Examiner that the subject matter is not supported by the disclosure").

Claim Rejections - 35 USC § 112 (Second Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, applicant compares the size of the memory to a magnetic disk or a CD. However, the amount of memory a CD or a magnetic disk does not particularly point out or distinctly claim the subject matter which applicant regards as his invention because the size of these devices could vary. The limitation "... to serve as an alternative to a magnetic disk or CD", does not further help to define the size of a magnetic disk or CD because a storage medium of even a single bit, byte or etc. can be used to serve as an alternative to a magnetic disk or CD (See Decision on Request for Rehearing dated May 24, 2010 pages 2-4). Therefore, the size of memory of a magnetic disk or CD could vary greatly.

Secondly, applicant states "... capable of storing software for installation to the computer or of receiving and storing..." This does clearly articulate whether the invention actually does this or is simply capable of doing this. In being capable of storing software, it does not necessarily mean that the memory device actually does store software, it simply means it has the ability to do so. Under the broadest reasonable interpretation, by having memory in the device would enable a device to be capable of storing software.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22-24 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Margalit et al. (US 6,748,541) (herein after Margalit).

As per claim 22., Margalit teaches a unitary portable data storage device (fig. 1, 10) which can be directly plugged into a universal serial bus (USB) socket of a computer (col. 5, lines 27-30) and which is operative to function as an alternative to a magnetic disk or compact disk (CD) (col. 7, lines 12-16), and which is capable of storing software for installation to the computer or of receiving and storing user's data present in the computer (col. 7, lines 12-16), the unitary portable data storage device comprising:

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (col. 5, lines 27-30);

an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug (col. 4, lines 42-49);

a non-volatile solid-state memory, said memory being non-removable from the unitary portable data storage device and having a memory space at least as large as

Art Unit: 2189

the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (col. 4, lines 38-41, See Board of Appeals and Interferences decision dated 11/20/2010 which on page 8 states "we do not see why the capacity, if interpreted to refer to an amount of memory, requires more than a single byte (or bit) of memory and furthermore on page 16 of the decision the Board continues to state "Margalit also teaches that the plug device can store confidential medical information. *Id.* at col. 7, 11.13-16. The reference thus discloses, or at least suggests, a memory storage capacity sufficient to meet the (unspecified) amount of storage capacity asserted by Appellant."); and

a memory controller, the memory controller being coupled between the interface and the memory to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (As illustrated in fig. 1, with CPU being between the interface and userdata memory), the data including at least user data that is not authorization data (col. 7, lines 12-16).

As per claim 23, Margalit teaches wherein the memory controller is non-removable from the unitary portable data storage device (As illustrated in col. 6, line 61 – col. 7, line 4 illustrates a non-removable memory controller within the definition of non-removable as defined and described in applicant's remarks and arguments dated 03/21/2005).

As per claim 24, Margalit teaches wherein the non-volatile solid-state memory is a flash memory (col. 4, lines 38-42).

As per claim 26, Margalit teaches wherein the memory controller comprises a micro-controller (col. 4, lines 23-26).

As per claim 27, Margalit teaches wherein the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller (col. 4, lines 35-37 and col. 10, lines 46-50).

As per claim 28, Margalit teaches wherein the unitary portable data storage device is sufficiently compact to maximize portability (col. 5, lines 63-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit as applied to claim 22 above, and further in view of Jha et al. (US 6,407,949) (herein after Jha).

As per claim 29, Margalit teaches all the limitations of claim 22 as described above and further teaches wherein the non-volatile solid state memory is accessible via the USB plug (as illustrated in fig. 1).

Margalit does not explicitly teach wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection.

However, Jha teaches wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection (As illustrated in fig. 4 and further described in col. 10, line 60 – col. 11, line 17)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the zoned password protection of Jha with the flash memory device of Margalit in order to prevent inadvertent erasures or reprogramming of portions of the flash memory (col. 11, lines 17-19).

As per claim 30, the combination of Margalit and Jha teaches wherein one or more of said plurality of zones require a unique password (Jha, fig. 4) received via the USB plug for access (Margalit, col. 5, lines 20-30 describes wherein information is transmitted to the device via the USB plug).

Response to Arguments

In response to terminal disclaimer filed 05 April 2011, the Non-Statutory Double Patenting Rejection has been withdrawn.

With respect to the 35 U.S.C. 112 rejection, first paragraph, Applicant argues that the original specification provides support for the recited limitation "...having a memory space at least as large as the memory space of the magnetic disk or CD," recited in claim 22. The crux of Applicant's argument relies on the fact that the cited portions describe wherein the portable data storage device can serve as alternative for magnetic disks and CD-ROMs, and in order to serve as an effective replacement, the portable

Art Unit: 2189

storage device must have a memory space that is at least as large as a magnetic disk or CD-ROM.

Applicant's arguments have been fully considered, yet are unpersuasive. With respect to Applicant's first argument, in order to serve as an alternative to a magnetic disk or CD-ROM, it is unclear why it is necessary for the portable storage medium to be of a particular size. For example if the magnetic disk or CD ROM was used to store a byte of information or even a bit, a portable storage medium of the size of a byte or bit would be able to perform the necessary functions to serve as an alternative (please refer to page 8, lines 18-21 of the decision by the Board of Appeals and Interferences dated 20 November 2009 wherein the Board states "[if] claim 22 were to specify that the 'capacity' refers to some minimum amount of memory by a number such as 1.44 MB, we would tend to agree with the examiner that the subject matter is not supported by the disclosure.")

As a result the 35 U.S.C. 112 rejection, first paragraph is maintained.

With respect to the 35 U.S.C. 112 rejection, second paragraph, Applicant's argue that a storage medium of a single bit or byte cannot serve as an alternative to a magnetic disk or CD. Applicant argues that in order to serve as an effective replacement for magnetic disks and CD-ROMs, the claimed portable data storage device must have a memory space that is at least as large as a magnetic disk or CD-ROM.

These arguments have been fully considered, but are unpersuasive for the reasons described above.

With respect to the 35 U.S.C. 112 rejection, second paragraph, Applicant's argue that the claimed language of "capable of" is definite because the claimed language "capable of" storing software is definite in expressing the portable data storage device's ability to store software if the user so chooses.

As Applicant has pointed the claimed does not positively recite whether data is stored or not because the user can choose to or not choose to and therefore does not clearly define the metes and bounds of the claim. Therefore, Applicant's remarks have been fully considered, but are found to be unpersuasive.

As a result the 35 U.S.C. 112 rejection, second paragraph is maintained.

With respect to the rejection of claims under 35 U.S.C. §102(e), Applicants arguments have been fully considered, but are unpersuasive.

Applicant's submit that Margalit does not disclose a data storage device that is able to serve as an alternative to a magnetic disk or a CD. As discussed above, serving as an alternative does not indicate that the device is of minimum size. As a result Margalit does teach storing data which serves as an alternative to a hard disk or CD (See col. 7, lines 12-16).

With respect to the rejection of claims under 35 U.S.C. § 103, Applicant's arguments have been fully considered, but are unpersuasive.

Applicant argues that one of ordinary skill in the art would have no reason to modify the FCCS device of Margalit to include a flash divided into a set of flash macros, as disclosed by Jha.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In this case, while one advantage to combining the divided flash of Jha with the FCCS is to provide access to data more quickly, the reason cited for combining Jha with Margalit is to prevent inadvertent disclosures or reprogramming of portions of the flash memory (col. 11, lines 17-19). These advantages would have motivated a person of ordinary skill in the art at the time of invention to have combined the divided flash of Jha with the FCCS of Margalit.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2189

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GURTEJ BANSAL whose telephone number is (571)270-5588. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on (571)272-4204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GB/

Application/Control Number: 09/803,173

Page 12

Art Unit: 2189

/Reginald G. Bragdon/

Supervisory Patent Examiner, Art Unit 2189